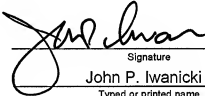


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 05032-00053	
I hereby certify that this correspondence is being submitted electronically with the U.S. Patent and Trademarks Office addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 1, 2008</u> Signature <u>Laurie Hall</u> Typed or printed name <u>Laurie Hall</u>		Application Number 10/815,942 Filed April 2, 2004 First Named Inventor Antoon J.G. van Rossum Art Unit 1792 Examiner Nicole R. Blan	
<p>Applicants request review of the non-final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. (See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,628</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">  Signature John P. Iwanicki Typed or printed name (617) 720-9600 Telephone number </div> <div style="text-align: center; margin-top: 20px;"> <u>May 1, 2008</u> Date </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Antoon J.G. van Rossum and)	Examiner:
Antonius F.M. Bertels)	Nicole R. Blan
)	
Serial No.: 10/815,942)	Art Unit: 1792
)	
Filed: April 2, 2004)	Conf. No.: 8940
)	
Title: REMOVABLE PROTECTIVE COATING)	

Commissioner for Patents
Mail Stop AF
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW

Dear Sir:

Applicants respectfully request pre-appeal brief review for the following reasons. MPEP

706 counsels that

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

MPEP 706 prevents piecemeal and revisionist prosecution should a case change Examiners as in the present application. Four years after the present application was filed, the Examiner has only now raised for the first time the concern that the claims are indefinite for claiming a removable coating. But, this language was included in claim 1 as originally filed and in claim 29 added by preliminary amendment. Primary Examiner Michael Kornakov issued four substantive Office Actions on October 26, 2005, May 25, 2006, February 5, 2007, and August 7,

2007 examining the claims on the merits and held a personal interview with the inventor and Applicants' attorney on March 15, 2006. The Primary Examiner never raised the issue that the claims were somehow not understandable.

In addition, the Examiner has not presented sufficient reasons for rejecting the claims as being indefinite to one of ordinary skill. The Examiner merely considers the removable coating not part of the claimed greenhouse, calling the removable nature of the coating "irrelevant." Applicants respectfully disagree. MPEP 2143.03 advises that there are no "irrelevant" claim limitations. The Primary Examiner understood the language because it is in fact very clear. The nature of the protective coating being removable is a physical characteristic of the coating which is appropriate for claiming. That is it removable with a removing agent comprising a base and a complex former is an entirely appropriate way to describe the chemical nature of the coating. One of ordinary skill in the art would readily understand the claims, and the Examiner has provided no evidence to the contrary. The failure of proof, the four substantive Office Actions and MPEP 706 indicate that the present rejection is inappropriate and should be withdrawn.

Likewise, MPEP 706 advises against resurrecting rejections based on art already applied by an Examiner and overcome by an applicant. In the present Office Action, the Examiner has cited the combination of van Rossum and Yoshida and the combination of JP-181 and Yoshida. However, van Rossum and Yoshida were cited by the Primary Examiner in the very first Office Action of October 26, 2005. Applicants responded on March 16, 2006. The Examiner maintained the rejection in a final Office Action mailed May 25, 2006. Applicants responded on November 20, 2006. Thereafter, the Examiner withdrew the combination of Van Rossum and Yoshida in favor of the combination of Yoshida and JP-181, again the very combination in the present Office Action. Applicants responded on June 5, 2007. The Examiner maintained the

rejection based on Yoshida and JP-181 in a final Office Action. As a result of seeking pre-appeal brief review, the rejection based on the combination of Yoshida and JP-181 was withdrawn.

Nearly two and a half years after issuance of the first Office Action, Applicants find themselves back at square one presented with the same art applied by the Primary Examiner, argued against by Applicants, and then withdrawn by the Primary Examiner, and not without substantial time, effort and expense by Applicants. The present Office Action presents no positions regarding the combination of the references not already presented by the Examiner and overcome by Applicants. The rehash of the art is an unjustified delay in the prosecution of this application. Accordingly, the rejection is inappropriate and should be withdrawn. All positions of Applicants with respect to Van Rossum, Yoshida and JP-181 are already of record in this case, and were persuasive enough to have the Examiner withdraw the rejections. Wiczorrek, cited as a secondary reference, fails to cure the deficiencies of the primary references for reasons of record. Should the rejections not be withdrawn, Applicants are faced with no option other than a formal appeal.

The Examiner admits that neither Van Rossum nor JP-181 teach the claimed polymer. The Examiner believes that one of skill would be motivated to optimize the materials of Yoshida and substitute them for that of either van Rossum or JP-181. But, the Examiner has presented no evidence that optimizing the materials of Yoshida, i.e. making those materials better for their intended uses, will result in the claimed polymer and its use as a binder in a protective coating for a greenhouse. In the Amendment and Response dated November 20, 2006 at pages 5-10, Applicants explained that Yoshida does not teach a polymer with the claimed combination of properties and also provides no instructions how to pick and choose from among the many

variables to arrive at the claimed subject matter.

“Optimization” is a convenient mantra for the Examiner, however, this mantra falls far short of the articulated reasoning supported by rational underpinnings required by the Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. ___, 14 (2007). In fact, *KSR* counsels against such a mere piecing together of prior art with conclusory statements of obviousness. The goal of *KSR* is to determine whether there “was an apparent reason to combine the known element *in the fashion claimed* by the [application] at issue.” *Id.* [Emphasis added].

The Examiner has not identified in Yoshida a polymer with the claimed properties that one could simply substitute for the polymer of either van Rossum or JP-181. The Examiner must first combine various properties from among the many polymers to arrive at the claimed polymer. One of skill must find some reason to consult Yoshida. However, the properties of the materials of Yoshida are so very different from the claimed polymer that one of skill would not consult Yoshida as a starting point for optimization, and the examiner has presented no evidence to the contrary. The materials of Yoshida provide no predictive value for arriving at the claimed subject matter. Also, the art is not so predictable that one of skill would reasonably expect to result in the removable protective coating including the claimed polymer as a binder simply by randomly selecting various polymer parameters from materials having very different properties.

As detailed in the Amendment and Response to Office Action dated November 20, 2006 at pages 5-10, Yoshida fails to teach or suggest the claimed protective coating on a greenhouse made from a pigment and binder having the recited weight average molecular weight, acid value, polydispersity and glass transition temperature. As explained, the Primary Examiner was clearly mixing values from different examples of Yoshida (i.e. alkali soluble film, acrylic rubber, alkali soluble adhesive) presumably because Yoshida provides no single actual example of a polymer

that expressly recites all of the claimed requirements of weight average molecular weight, acid value, polydispersity and glass transition temperature. In fact, Yoshida describes very different products having very different utilities such as alkali-soluble adhesives, alkali-soluble films, pressure sensitive adhesives, acrylic rubbers, alkali-soluble injection moldings and water inks. Each of these specific products would likely have very different physical and chemical properties, and are presumably not interchangeable, i.e. an acrylic rubber will likely not serve as a water ink, which likely will not serve as an alkali-soluble film. In fact, Yoshida fails to disclose claimed values for all four claimed parameters for any of the polymer examples. Many of the polymer examples have one or more parameters that are outside those recited in the present claims, and some have missing parameters.

There is no teaching in Yoshida, and none has been advanced by the Examiner, that would lead one to alter the Yoshida materials. Finding pieces of the claimed invention among the prior art does not support an obviousness determination. Optimizing the materials of Yoshida, i.e. making those materials better for their intended uses, does not lead one of skill to the claimed invention, and there is no evidence to the contrary. Only Applicants' specification provides the roadmap to arrive at the claimed materials, and the Examiner cannot use that roadmap. Without such a teaching guiding one of skill to Yoshida, there is no articulate reasoning or rational underpinning to support an obviousness rejection under *KSR*.

Respectfully submitted,

Dated: May 1, 2008


John P. Iwanicki, Reg. No. 34,628
BANNER & WITCOFF, LTD.
28 State Street, 28th Floor
Boston, MA 02109
(617) 720-9600